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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,883	11/08/2000	Naohiko Matsuda	PM272992	1379

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

12

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/707,883

Applicant(s)

MATSUDA ET AL.

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/29/03, Amendment C.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/294,713.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 1/29/03. Claims 11-14 were added. Claims 1-13 and 11-14 are pending.
2. The rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Doderer-Winkler (of record), as set forth in the previous office action, has been withdrawn in light of Applicants' arguments.
3. The rejection of claim 1 under 35 U.S.C. 103(a) as being unpatentable over Doderer-Winkler in view of Rodriguez (of record), as set forth in the previous office action, has been withdrawn in light of Applicants' arguments.
4. The rejection of claims 1-3 under 35 U.S.C. 103(a) as being unpatentable over Kluger (of record) in view of the collective teachings of Lindstrom et al. (of record) and Adachi (of record), and Rodriguez, as set forth in the previous office action, has been withdrawn in light of Applicants' arguments.

Specification

5. The disclosure is objected to because of the following informalities: Applicants admit in previous response dated 1/29/03 (p. 3, 2nd paragraph) that "silicon" should be --silicone--. It is suggested that Applicants make the necessary changes throughout.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 11, it is unclear what is meant by “to position the attaching roller into the predetermined position.” The “predetermined position” refers to the position of the member (see claim 1), so there is no way that the attaching roller can occupy the same position. Do Applicants mean that the attaching roller is positioned into contact with the member? Applicants are asked to clarify.

Regarding claim 14, it is unclear what is meant by “an elastic support portion.” The specification discloses the support portion being a flexible spring or flexible pipe, but says nothing about elasticity (p. 9, lines 19-21; p. 13, lines 4-15). Applicants are asked to clarify. It is suggested to change “an elastic” to --a flexible--.

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ozawa et al. (JP 6-293322; abstract and on-line translation).

It is noted that Applicants define an adhesive tape as a substrate comprising an adhesive surface and an opposite, non-adhesive surface.

With respect to claim 1, Ozawa, directed to attaching a label to a floppy disk, teaches placing the label 20 on a release paper 22 such that the adhesive surface of the label contacts the release paper, rolling an attaching roller 12 having an adhesive strength on an opposite, non-

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adhesive surface of the label to remove the label from the release paper, and rolling the attaching roller on a surface of a floppy disk 26 located in a predetermined position so that the label adhered to the attaching roller is transferred to and attached to the floppy disk (Figures 1-2; [0006-0007] of translation). The reference teaches the adhesive strength between the adhesive surface of the label and the release paper being less than the adhesive strength between the non-adhesive surface of the label and the attaching roller, which is less than the adhesive strength between the adhesive surface of the label and the floppy disk (last three lines of [0007]).

Regarding claim 11, the reference teaches moving the attaching roller along the Y-axis and rotating it along the theta-axis (Figures 2 and 5; [0007]).

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al.

With respect to claim 1, it is noted that the examiner interpreted the reference to mean that the adhesive strength between the adhesive surface of the label and the release paper is less than the adhesive strength between the non-adhesive surface of the label and the attaching roller, which is less than the adhesive strength between the adhesive surface of the label and the floppy disk. If it is not taken that this is so, because the reference fails to explicitly state it, one reading the reference as a whole would have readily appreciated that such a relationship between the label and the release paper, attaching roller, and floppy disk would have to exist in order for the invention to work.

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12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. in view of Lindstrom (US 4321103; of record).

Regarding claim 2, Ozawa teaches the release paper being transported along a conveyor belt 10 (Figure 1; [0007]), but it is silent as to the adhesive surface of the label being in contact with the conveyor belt. It is known in the art to transport a label on a surface-treated conveyor belt with the adhesive surface of the label contacting the belt so that the label can be easily removed from the conveyor and attached to an article, as taught by Lindstrom (column 2, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to transport the label of Ozawa on a surface-treated conveyor belt with its adhesive surface in contact with the conveyor because such is known in the art, as taught by Lindstrom, and this would eliminate the need for the release paper without sacrificing easy transfer of the label from the conveyor to the attaching roller.

13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. in view of Adachi (US 4468274; of record).

Regarding claim 3, Ozawa teaches a plurality of labels (Figure 1) but is silent as to cutting them from a roll. It would have been obvious to one of ordinary skill in the art at the time the invention was made to cut the labels of Ozawa from a roll before placing them on the conveyor because such is known in the art, as taught by Adachi (Figure 2), and this allows the roll to be stored and continuously supplied throughout the process.

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14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. in view of the collective teachings of Horai et al. (US 5714028), Urban et al. (US 6080250), and Matuda et al. (US 4725327).

Regarding claim 13, Ozawa teaches the attaching roller being moved by multi-axis equipment 28 (Figure 1), but is silent as to the equipment being a hand portion of a multi-axis robot. It is known in the art to apply labels to objects by moving the label into contact with the object and pressing it thereto or by just pressing the already-applied label against the object using a mechanism, not limited to a roller, that is manipulated by a hand portion of a multi-axis robot, as taught by the collective teachings of Horai (Figures 1 and 6), Urban (Figure 1; column 4, lines 8-10), and Matuda (Figure 1; column 1, lines 8-10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a hand portion of a multi-axis robot to move the attaching roller of Ozawa because such is known in the art, as taught by the collective teachings, and one reading the reference as whole would have appreciated that the equipment 28 is not critical to the invention such that a robot hand would serve as an alternative for moving the attaching roller where only the expected results would have been achieved.

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa et al. in view of Selak et al. (US 5133396).

Regarding claim 14, Ozawa et al. is silent as to an elastic support portion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a flexible, biasing spring into the attaching roller of Ozawa because such is known in the art, as

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taught by Selak (column 2, lines 65-67; column 3, lines 5-8), where the spring allows for pressure control during label application (column 3, lines 5-8).

Allowable Subject Matter

16. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 12, the prior art fails to teach or suggest the member being a curved glass panel and the attaching roller being rolled onto a slanted upper or slanted lower surface of the glass panel to transfer the tape thereto.

Response to Arguments

17. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi
Patent Examiner
Art Unit 1733



jl
March 5, 2003


Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700